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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,826	09/20/2000	Luke E. Girard	042390.P8184	8683

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EXAMINER
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ART UNIT	PAPER NUMBER
2131	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/665,826	GIRARD ET AL.	
	Examiner	Art Unit	
	Christopher A. Revak	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *see attached*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed September 23, 2004, with respect to the rejection of claims 1-22 under 35 U.S.C. 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new grounds of rejection is made in view of Westberg et al and Nishimura.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on September 23, 2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: deleting protected

data to a requestor and not delivering protected data to the requestor. Suitable elements can also recite the intent to "protect against unauthorized monitoring and/or unauthorized copying" as is recited in the applicant's specification. The claims, as currently recited, "delete all data in response to requests from a requestor and do not deliver the data to the requestor" as is recited in independent claims 1 and 6. The current claim language shows no distinction between what data is deleted, but rather recites that all data is deleted and has no utility. Independent claims 11 and 17 disclose of "preventing protected data from being delivered to a requestor" whereby independent claims 1 and 6 do not distinguish this feature.

Claim Objections

6. Claims 11,16,17, and 22 are objected to because of the following informalities:

In claim 11, line 5 and 6; claim 16, line 2; claim 17, lines 9 and 10; and claim 22, line 2, it is recited of "data" which creates confusion in the claim language since it is later recited of "protected data" and appears that the "data" is to be "protected data".

In claim 17, line 8, it is recited "and" that needs to be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 11,13,14,19, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Westberg et al, U.S. Patent 4,862,156.

As per claims 11 and 17, Westberg et al discloses of an apparatus and system (col. 1, lines 7-13). The apparatus and system comprise a ROM (presentation buffer) and a microprocessor (command handler) for processing commands and addresses (col. 4, lines 34-44). A protection circuit (data handler) coupled to the ROM (presentation buffer), monitors data and to pass atleast a part of the data to the ROM (presentation buffer)(col. 3, lines 2-17,25-29). A select circuit (security violation detector) detects a read request by a requestor to read protected data in the ROM (presentation buffer)(col. 3, lines 10-13 and col. 4, lines 34-40). A latching circuit (data protector), coupled to the protection circuit (data handler) prevents providing the protected data to the requestor (col. 3, lines 14-19).

As per claims 13 and 19, Westberg et al discloses that the graphics controller is a presentation controller (col. 1, lines 9-13). The teachings additionally disclose of the use of ROM (presentation/frame buffer)(col. 4, lines 34-40).

As per claims 14 and 20, it is disclosed by Westberg et al that the graphics (presentation) controller includes a by-pass mode that does not prevent providing the protected data to the requestor (col. 2, lines 40-51 and col. 3, lines 4-10).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-4,6-9,12,15,18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westberg et al, U.S. Patent 4,862,156 in view of Nishimura, U.S. Patent 5,928,361.

As per claims 1 and 6, it is disclosed in the teachings of Westberg et al of a method and machine readable medium having stored thereon instructions executed by a processor (col. 1, lines 7-13 and column 9, lines 7-11). Data is received in ROM (presentation buffer) of a graphics (presentation) controller (col. 4, lines 34-40). A request is received from a requestor to read the data in the ROM (presentation buffer)(col. 4, lines 34-44). The data is not delivered to the requestor in response to the request (col. 3, lines 24-32). The teachings of Westberg et al are silent in disclosing deleting the data in memory (presentation buffer) in response to a request. It is disclosed by Nishimura of deleting the contents of memory in response to a request (col. 1, lines 66-67 and col. 2, lines 4-6). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to apply protection means for preserving the contents of memory. Nishimura recites motivation by disclosing of problems in the prior art known for making it impossible to keep the secrecy of data stored in memory (col. 1, lines 48-50) and overcomes this problem in order to keep the secrecy of stored data (col. 2, lines 26-27). It would have been obvious that the teachings of Westberg et al would have found the teachings of Nishimura beneficial as a means of keeping the secrecy of stored data.

As per claims 2 and 7, Westberg et al discloses that the graphics controller is a presentation controller (col. 1, lines 9-13).

As per claims 3 and 8, Westberg et al discloses that receiving data places the graphics controller (presentation controller) in a security mode (col. 2, lines 56-59 and col. 3, lines 24-29).

As per claims 4 and 9, Westberg et al teaches of taking the graphics controller (presentation controller) out of a security mode (col. 2, lines 40-45).

As per claims 12 and 18, it is taught by Westberg et al of a latching circuit (data protector), coupled to the protection circuit (data handler) prevents providing the protected data to the requestor (col. 3, lines 14-19). The teachings of Westberg et al are silent in disclosing purging the data in memory (presentation buffer) in response to a request. It is disclosed by Nishimura of deleting (purging) the contents of memory in response to a request (col. 1, lines 66-67 and col. 2, lines 4-6). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to apply protection means for preserving the contents of memory. Nishimura recites motivation by disclosing of problems in the prior art known for making it impossible to keep the secrecy of data stored in memory (col. 1, lines 48-50) and overcomes this problem in order to keep the secrecy of stored data (col. 2, lines 26-27). It would have been obvious that the teachings of Westberg et al would have found the teachings of Nishimura beneficial as a means of keeping the secrecy of stored data.

As per claims 15 and 21, Westberg et al teaches of a graphics (presentation) controller that includes a by-pass mode that does not prevent providing the protected

data to the requestor (col. 2, lines 40-51 and col. 3, lines 4-10). The teachings of Westberg et al are silent in disclosing purging the data in memory (presentation buffer) in response to a request. It is disclosed by Nishimura of deleting (purging) the contents of memory in response to a request (col. 1, lines 66-67 and col. 2, lines 4-6). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to apply protection means for preserving the contents of memory. Nishimura recites motivation by disclosing of problems in the prior art known for making it impossible to keep the secrecy of data stored in memory (col. 1, lines 48-50) and overcomes this problem in order to keep the secrecy of stored data (col. 2, lines 26-27). It would have been obvious that the teachings of Westberg et al would have found the teachings of Nishimura beneficial as a means of keeping the secrecy of stored data.

11. Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westberg et al, U.S. Patent 4,862,156 in view of Nishimura, U.S. Patent 5,928,361 in view of Schreiber et al, U.S. Patent 6,298,446.

The combination of the teachings of Westberg et al and Nishimura fail to disclose of delivering data other than the requested data in regards to a user request. It is disclosed by Schreiber et al of delivering substitute data (delivered data other than the requested data) to a requestor (col. 3, lines 39-47). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to apply protection measures to ensure that protected data is not view by an unauthorized requestor. Schreiber et al discloses motivation by reciting that there exists a need to

protect an original copy of software from being illegally copied wherein the original data is not provided to a user (col. 3, lines 12-14). It is obvious that the combined teachings of Westberg et al and Nishimura would have found the teachings of Screiber et al beneficial of providing data other than the requested data as a means of protecting data from being illegally copied as is the intent of the teachings of Westberg et al to prevent pirate programs from being executed on the graphics controller (col. 2, lines 60-64).

12. Claims 16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westberg et al, U.S. Patent 4,862,156 in view of Schreiber et al, U.S. Patent 6,298,446.

The teachings of Westberg et al fail to disclose of delivering data other than the requested data in regards to a user request. It is disclosed by Schreiber et al of delivering substitute data (delivered data other than the requested data) to a requestor (col. 3, lines 39-47). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have been motivated to apply protection measures to ensure that protected data is not view by an unauthorized requestor. Schreiber et al discloses motivation by reciting that there exists a need to protect an original copy of software from being illegally copied wherein the original data is not provided to a user (col. 3, lines 12-14). It is obvious that the teachings of Westberg et al would have found the teachings of Screiber et al beneficial of providing data other than the requested data as a means of protecting data from being illegally copied as is the intent of the teachings of

Westberg et al to prevent pirate programs from being executed on the graphics controller (col. 2, lines 60-64).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sonobe, U.S. Patent 6,167,519 discloses of storing secret information that is protected from unauthorized access.

Klein, U.S. Patent 6,011,473 discloses of erasing contents of a computer upon detection of theft.

McBride, U.S. Patent 5,675,321 discloses of disabling access to content stored on a computer in response to detection of unauthorized removal of the computer.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Revak
AU 2131

CR

February 21, 2005

2/21/05